

REMARKS

Claims 1, 2, and 7 have been amended. Claims 8-38 were canceled, and claim 39 has been withdrawn as being directed to a non-elected invention. Applicant asserts that the amendments do not raise new issues or matter. Upon entrance of the amendments, claims 1-7 will be pending in the captioned application. Alternately, the amendments should be considered to place the case in better form for consideration on appeal. Entrance of the amendments and further examination and reconsideration of claims 1-7 are respectfully requested.

Priority Claim Under 35 U.S.C. 119(c)

The Final Office Action states that "[p]riority to provisional US application 60/153,941 remains denied for the reasons states in the previous Office Action." (Final Office Action – page 2.) Applicant respectfully disagrees. For at least the reasons set forth in the Responses previously filed in the case, Applicant respectfully submits that the priority date of September 15, 1999, the filing date of Provisional Application 60/153,941, is the proper priority date for the present application. Accordingly, Applicant respectfully requests that the denial of priority to Provisional Application 60/153,941 be withdrawn.

Double Patenting Rejections

Claims 1-7 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, 7, and 8 of U.S. Patent No. 6,524,793 to Chandler et al. in view of International Publication No. WO 99/19515 to Chandler et al. (hereinafter "the International Publication"). Applicant respectfully traverses these rejections. However, to expedite prosecution, a Terminal Disclaimer is submitted in separate paper to obviate the double patenting rejections in accordance with 37 C.F.R. § 1.321(c). The Terminal Disclaimer is believed sufficient to overcome any assertion of judicially created obviousness-type double patenting between the present claims and claims of U.S. Patent No. 6,524,793 to Chandler et al. Accordingly, removal of the double patenting rejections of claims 1-7 is respectfully requested.

Section 102 Rejections

Claims 1-7 were rejected under 35 U.S.C. § 102(b) as being anticipated by Kettman et al. (Cytometry (1998) 33:234-243) (hereinafter "Kettman"). As will be set forth in more detail below, the § 102 rejections of claims 1-7 are respectfully traversed.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987), MPEP § 2131. Regardless of whether or not Kettman is available as prior art under 35 U.S.C. § 102(b), Kettman does not disclose all limitations of the currently pending claims, some distinctive limitations of which are set forth in more detail below.

The cited art does not teach a Multi-Analyte Profile (MAP) Test Panel that includes 75 or more subsets of microspheres. Amended independent claim 1 recites in part: "A Multi-Analyte Profile (MAP) Test Panel comprising 75 or more subsets of microspheres." Independent claim 7 has been amended to recite a similar limitation. Support for the amendments to the independent claims can be found in the Specification, for example, on page 3, lines 27-28.

Kettman discloses classification and properties of 64 multiplexed microsphere sets. Kettman, however, does not disclose a Multi-Analyte Profile (MAP) Test Panel that includes 75 or more subsets of microspheres. For example, Kettman states that "The hardware and software were designed to identify, in real time, sets of microspheres based on their fluorescence." (Kettman -- page 234, col. 1.) In addition, Kettman states that "The Luminex Corporation has prepared 64 microsphere sets that can be discriminated when analyzed as a mixture by the FlowMetrix system." (Kettman -- page 238, col. 2.) Therefore, Kettman discloses that 64 microsphere sets were analyzed. However, Kettman does not disclose that more than 64 microsphere sets were analyzed or could be analyzed. For example, Kettman does not disclose that the measurement system could analyze more than 64 microsphere sets. In particular, Kettman states that "This measurement system can analyze up to 64 analytes in a single sample." (emphasis added, Kettman -- abstract, col. 1). Therefore, Kettman does not suggest or provide motivation for testing more than 64 microsphere sets since Kettman discloses that the particular measurement system that was used in the experiments cannot analyze more than 64 analytes in a single sample. As such, Kettman does not teach, suggest, or provide motivation for a Multi-Analyte Profile (MAP) Test Panel that includes 75 or more

subsets of microspheres, as recited in claims 1 and 7. Consequently, Kettman does not teach, suggest, or provide motivation for all limitations of claims 1 and 7.

For at least the aforementioned reasons, claims 1 and 7 are not anticipated by the cited art. Therefore, claims 2-6, which depend from claim 1, are also not anticipated by the cited art for at least the same reasons. Accordingly, removal of the § 102 rejections of claims 1-7 is respectfully requested.

CONCLUSION

This response constitutes a complete response to all issues raised in the Final Office Action mailed January 22, 2004. In view of the remarks traversing rejections presented therein, Applicants assert that pending claims 1-7 are in condition for allowance. If the Examiner has any questions, comments, or suggestions, the undersigned earnestly requests a telephone conference.

The Commissioner is authorized to charge any required fees or credit any overpayment to Conley Rose, P.C. Deposit Account No. 03-2769/5868-02801.

Respectfully submitted,



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